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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,796	06/23/2003	Morris Samelson	P-5435(DIV1)	7988

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EXAMINER

CHANNAVAJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,796

Applicant(s)

SAMELSON ET AL.

Examiner

Lakshmi S. Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt of response and IDS dated 1-19-06 is acknowledged.

Claim 1-18 are pending in the instant application.

Instant claims 1-17 are directed to a composition consisting of a mixture of at least 50% by weight of processed Dead Sea mineral particles suspended in a continuous all-natural carrier medium, consisting of oil and at least one essential oil. According to the instant claims the carrier medium consists of oil and at least one essential oil, thus allowing for more than one essential oil.

Response to Arguments

Applicant's arguments filed 1-19-06 have been fully considered and the following action is applied:

Claim Rejections - 35 USC § 112

1. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Applicants amended instant claims to delete the word 'anhydrous" and accordingly, the above rejection have been withdrawn.

The following is a new rejection applied to the instant claims:

Claim Objections

2. Claims 4-15 and 17 are objected under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s)

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to place the claims in proper dependent form, or rewrite the claims in a dependent form.

Instant claims 4-15 are improperly dependent on the preceding claim. Claim 2 recites oils comprising all natural carrier medium in a markush format. Claim 3 recites that the oil of claim 2 is soybean oil, which is proper. While each of the claims 4-10 recites single oil as the carrier medium, they are improperly dependent upon on the previous claim. Instead a proper method of claim presentation is to make each of the claims 4-10 depend on claim 2.

Claim 10, dependent from claim 9, recites "further comprising vitamin E oil", which is improper. However, claim 9 dependent upon claim 1 is closed for any additional ingredients other than recited in claim 1, due to the phrase "consisting of".

Claim 11 recites "further comprising an essential oil blend wherein said essential oil blend comprises said at least one essential oil", which is improper because claim 1 from which claim 11 depends is closed for any additional ingredients other than recited in claim 1 due to the phrase "consisting of". Accordingly it is improper to add any ingredients to claim 1 by way of reciting "further comprising".

Claim 17 is objected because it is dependent on an improperly dependent claim (claim 11). Claims 13-15 are objected to because they are dependent on an improperly dependent claim, as explained above.

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Examiner notes that each of the claims 2-15 and 16 recite the word "comprises", which is improper because the above claims depend directly or indirectly on claim 1, which recites the transitional phrase "consisting of" that is closed for additional ingredients other than recited in claim 1, whereas the word "comprises" in each of the claims is open for the inclusion of additional ingredients. Accordingly, it is suggested that the above claims be amended to recite the word "is" in place of "comprises".

Claim Rejections - 35 USC § 103

3. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0211062 to Laden et al (Laden) in view of 5,997,889 to Durr et al ('889).

Laden teaches anhydrous skin cleansers comprising emollient oils (0021), emulsifying agents (0030-0032), substantially crystalline abrasive materials (0033-0036) and other additives such as tocopherol, fragrances etc. Laden teaches that the crystalline abrasive material is used at a concentration of 1-60% (0014), to provide sufficient abrasive effect in the removal of soils, without irritating or scratching of the skin. For the amounts of individual ingredients, Laden teaches 1-60% crystalline abrasive material, 30% to 90% emollient oil, 1% to 20% oil-gelling agent, 1% to 15% emulsifying agent (0017) etc. While Laden suggests employing abrasives at a concentration of 1-60%, and not the claimed "at least 50% of the weight of the composition" absent evidence to the

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unexpected advantage, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to choose the amount of abrasive material between 1% to 60% and still expect the advantage of skin cleansing without irritation (0033).

Examples 1 and 8 particularly recite Dead Sea salt as an abrasive. With respect to the particle size, Laden suggests that the particle size ranges from 50 to 1000 microns, which includes the claimed particle size of less than 1 mm (claims 16 and 18). Thus, the abrasive particles of Laden meet the claimed size range i.e., 100% particles consisting of an ultra-fine uniform granularity of less than 1.0 mm granularity. For water-immiscible emollient oils, Laden teaches oils that are also claimed in the instant invention. Laden teaches including fragrances in the composition but not essential oils of the instant claims.

'889 teaches hand and body cream for skin ailments such as dry, itchy skin, eczema, psoriasis etc., comprising oils such as almond oil, jojoba oil, vitamin e oil, for moisturizing and conditioning of skin (col. 2) and beeswax for forming a protective barrier (col. 3). Further, '889 teach addition of fragrances such as rosewood, chamomile, calendula, lavender, etc (col.4, lines 43-58), as essential oils for providing immediate relief from skin discomfort. It would have been obvious for one of an ordinary skill in the art at the time of the instant invention to include the emollients such as jojoba oil, waxes and fragrances/essential oils of '889 in the composition of Laden containing Dead sea salts because '889 teaches the ingredients for moisturizing and providing relief to psoriatic or itchy skin conditions. Therefore, a skilled artisan would have

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expected to achieve moisturization and also provide immediate relief from skin discomfort.

Claims 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over KR 149428 (KR).

KR teaches a cosmetic composition comprising large quantities of salt (15%-85%) such as bay salt, Dead Sea salt or bamboo salt, having a particle size of 0.1mm to 5.00 mm (page 3, 4th full paragraph), oil, surfactant and a polyol (abstract). Further, the particle size of salts taught by KR includes the claimed sizes (instant claims 16 and 18). While KR teaches a range for the particle size that ranges from less than 1 mm to more than 1mm, absent evidence to the unexpected advantage of the claimed particle size i.e., less than 1.0 mm, it would have been obvious for one of an ordinary skill in the art at the time of the instant to choose a particle of Dead Sea salts between 0.01 mm to 5.0 mm in the cosmetic composition of KR and still expect to provide an effective skin scrubbing composition that is pleasant to touch and not irritating skin.

Response to Arguments:

Applicants argue that none of the references cited teach a mixture of at least 50% by weight of the total composition of processed Dead Sea salts suspended in a continuous all natural carrier medium consisting of an oil and at least one essential oil, the limitations of claim 2, 11,16 etc. The present action rejects claims as being obvious over the teachings of Laden in view of Durr,

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which teach the claimed composition for skin treatment. While Laden teaches only fragrance in the composition, Durr teaches the claimed essential oils as fragrances and their advantage in providing immediate skin relief thus providing the required motivation to include the essential oils in the composition of laden.

It is argued that the instant processing step for any version of the Dead Sea minerals ensures that 100% will have less than 10 mesh and 100% will have less than 1.0 mm size granularity. Instant specification does not define the term "processed" to the above granularity of 100% will have less than 10 mesh and 100% will have less than 1.0 mm size granularity. Further, Laden teaches particles in the range of 50 to 1000 microns that is clearly in the claimed particle size range. While applicants agree that Laden and KR teach claimed large amounts of Dead Sea salts, it argued that the references fail to teach Dead Sea Salts alone. This argument is moot because the claims are rejected as being obvious over the prior art teachings and not as being anticipated by the references. Further, instant claims recite a composition that includes not just Dead Sea salts but also other components, which is also taught by Laden. With respect to the argument regarding 100% processed salts with specific granularity, as explained above, applicants have not provided any unexpected result with respect to the claimed granularity.

Applicants' argument regarding the teachings of KR that the disclosure of a foreign reference is to be measure not by what may be made out of it, but that what is clearly and definitely expressed in it, and that foreign prior art is to be strictly construed and restricted to what is clearly and definitely disclosed therein,

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not that which may be made out of it. Applicants' primarily argue regarding the teachings of oil-in-polyol as opposed to instant Dead Sea particles suspended in all natural carrier medium. It is also argued that KR does not claim the Dead Sea salts alone, but only as they are found within a composition. Applicants' arguments are not persuasive because KR reference is only applied to claim 18 only, which does not require any carrier medium of claim 1. The argument that KR fails to claim Dead Sea salts is not persuasive because the prior art clearly teaches Dead Sea salts and does not have to claim. [W]hen the patented document is used as a patent and not as a publication, the examiner is not restricted to the information conveyed by the patent claims but may use any information provided in the specification which relates to the subject matter of the patented claims when making a rejection (MPEP 2126.02). Therefore the argument that the composition claimed in KR is made up of ultra-fine uniform specific granularity size rather than of dead sea salts minerals mixed of mixed various particle sizes all within the claimed range of KR. In addition applicants have not provided any unexpected advantage of particle sizes of less than 1.00 mm as opposed to the range taught by KR, whereas one of an ordinary skill in the art would have understood from the teachings of KR that the composition containing 15% to .85% Dead sea salts, in the particle size range of 0.01 mm to 5mm would be very effective as a skin scrub without causing any skin irritation.

Applicants argue that the three references i.e., KR, Laden and Durr are not combinable to produce the present invention and that KR actually teaches away from combining because KR teaches oil-in-water or water-in-oil and that

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water in the emulsions of KR has a draw back that salts cannot be used in large quantities. However, instant rejection of claims 1-17 does not include KR and hence the arguments are not pertinent. With respect to the argument that Durr teaches water, Durr is combined only for the teaching of essential oils in a skin composition to provide instant relief from skin discomfort from itchy and dry skin and to moisturize skin, which is also desired by Laden and not for the teaching of an emulsions or carrier medium.

Applicants state that the Declaration of Joseph P. Ettari submitted on 6-5-06, provides additional supporting evidence that the present invention is not obvious to one skilled in the art. It is argued that the combination of these references constitutes improper hindsight analysis, as there simply is no positive direction in the prior art of the claimed invention.

The declaration filed on 6-5-06 has been considered but not found persuasive. Joseph Ettari states that at Estee Lauder he was aware of, had seen and worked with cosmetic compositions containing Dead Sea minerals in a range of varying granularity and concentrations. However, he states that the Dead Sea salts used at Estee Lauder are quite distinct from the Dead Sea salts disclosed in the present invention, that prior to the present invention he has not seen minerals with the claimed granularity that is uniform through out the composition and that never in the history of Estee Lauder that a product containing high concentration, 100% being less than 1.0 mm been known to exist in the cosmetic industry. Thus, the statements of Joseph are limited to his experience in Estee Lauder and not outside. While Joseph Ettari is unaware of the Dead Sea particles in the

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claimed granularity and concentrations, the cited prior art references of Laden and KR patent clearly teach granular Dead Sea salts, in amounts as high 60% (Laden) and KR (85%) and Laden further teaches particle sizes of 50 microns to 1000 microns. Instant claims only state less than 1.0 mm but do not specify any specific size below 1 mm, whereas the prior art of record suggests as low as 0.01 mm i.e., 10 microns (KR) or 50 microns (Laden). Accordingly, Dead Sea salts of the claimed granularity are known in the art before the instant invention. With respect to the 100% of salts being in the claimed granular sizes, Laden recognizes that the particle size as a result effective variable because Laden states that the particle size should be such that it serves effective scrubbing without irritating the skin. In this regard, Laden clearly states 50-1000 microns is effective for scrubbing. KR also teaches particle sizes below 1 mm. [W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d454, 456, 105 USPQ 233, 235 CCPA. Hence, in the absence of any unexpected advantage or criticality of the claimed particle sizes and their uniformity, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to choose an appropriate particle size of Dead Sea salts in the teachings of Laden or KR and maintain the uniformity of the particle sizes with an expectation to achieve the desired scrub effects with the compositions comprising Dead sea salts.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM - 6.30 PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lakshmi S Channavajjala
Examiner
Art Unit 1615

June 30, 2006